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OFFICE OF PETITIONS

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In re Application of	:	
Ryoji Kaneko	:	
Application No. 10/709,971	:	DECISION ON PETITION
Filed: June 10, 2004	:	PURSUANT TO
Attorney Docket Number:	:	37 C.F.R. § 1.181
SIMTEK6915	:	
Title: BRUSH TYPE DC ELECTRIC	:	
MACHINE	:	

On September 9, 2006, Petitioner presented a submission, which is properly treated as a petition pursuant to 37 C.F.R. § 1.181 to review a decision of a Technology Center Director, as well as petitions pursuant to 37 C.F.R. § 1.137(a) and 37 C.F.R. § 1.137(b) to revive the above-identified application. Duplicate copies of this submission were submitted on September 10, 2006 and November 3, 2006.

This is a decision on the petition pursuant to 37 C.F.R. § 1.181. A decision on the petition pursuant to 37 C.F.R. §§ 1.137(a) and 137(b) will be mailed under separate cover.

The Office regrets the period of delay in issuing this decision.

The petition pursuant to 37 C.F.R. § 1.181 is **DISMISSED**.

A discussion follows.

Background

The above-identified application became abandoned for failure to submit an Appeal Brief within two-months of the filing of a Notice of Appeal, filed on December 20, 2005. An Appeal Brief

was received on August 7, 2006 along with the required fee. No extensions of time pursuant to 37 C.F.R. §1.136(a) were received. Accordingly, the above-identified application became abandoned on February 21, 2006. A Notice of Abandonment was mailed on September 5, 2006.

The Relevant Portions of the C.F.R. and M.P.E.P.

37 C.F.R. § 1.181(f) sets forth, *in toto*:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 C.F.R. § 1.134 sets forth, *in toto*:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

37 C.F.R. § 1.136(a)(1) sets forth, *in toto*:

(1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

(i) Applicant is notified otherwise in an Office action;

(ii) The reply is a reply brief submitted pursuant to § 41.41 of this title;

(iii) The reply is a request for an oral hearing submitted pursuant to

§ 41.47(a) of this title;

(iv) The reply is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.304 or to § 41.50 or § 41.52 of this title; or
(v) The application is involved in a contested case (§ 41.101(a) of this title).

(2) The date on which the petition and the fee have been filed is the date for purposes

37 C.F.R. § 41.37(a)(1) sets forth, *in toto*:

Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

M.P.E.P. § 1205.01 sets forth, *in pertinent part*:

37 CFR 41.37(a) provides 2 months from the date of the notice of appeal for the appellant to file an appeal brief and the appeal brief fee set forth in 37 CFR 41.20(b)(2). In an ex parte reexamination proceeding, the time period can be extended only under the provisions of 37 CFR 1.550(c). See also MPEP § 2274.

The usual period of time in which appellant must file his or her brief is 2 months from the date of appeal. The Office date of receipt of the notice of appeal (and not the date indicated on any Certificate of Mailing under 37 CFR 1.8) is the date from which this 2-month time period is measured. See MPEP § 512. If the notice of appeal is filed in accordance with 37 CFR 1.10 using the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS), the date of deposit with the USPS is the date from which this 2-month time period is measured because the date of deposit shown by the "date in" on the "Express Mail" label or other official USPS notation is considered to be the date of receipt. See MPEP § 513.

ANALYSIS OF THE PETITION PURSUANT TO 37 C.F.R. § 1.181

The Office mailed a final Office action on September 20, 2005, which set a shortened statutory period for reply of three months. An after-final amendment was received on December 5, 2005, and an advisory action was mailed on December 19, 2005. On December 20, 2005, Applicant concurrently submitted a notice of appeal along with the associated fee, as well as a petition requesting that the Commissioner "exercise his supervisory authority and direct the Examiner to enter the amendment filed by fax on December 5, 2005."

Pursuant to 37 C.F.R. § 41.37(a)(1), Applicant was required to submit an appeal brief no later than February 20, 2005. Extensions of time were available, up to five months, pursuant to Rule § 1.136(a). Consequently, the maximum extendable period for response expired on July 20, 2005 at midnight.

On March 19, 2006, Applicant submitted a second petition, which was substantially identical to that which was submitted on December 20, 2005.

The Office mailed a decision on the petitions of December 20, 2005 and March 19, 2006 on August 1, 2006, and indicated that Petitioner's request was "denied," as the proposed amendment would "alter the scope of the claimed invention and create a new issue requiring further search and consideration."

On August 7, 2006, Applicant submitted an Appeal Brief along with the associated fee. However, as indicated above, the Appeal Brief was due no later than February 20, 2006¹. The present application went abandoned for failure to timely submit the Appeal Brief.

On August 7, 2006, Applicant also filed a "request to consider attached appeal brief and brief fee as being timely filed," which was denied by the Office via the mailing of a decision on September 2, 2006.

With the present petition, Petitioner has set forth "before the decision on August 1, 2006, the undersigned earnestly believed the Office would act honorably and enter the amendment²."

As such, it appears that Petitioner submitted a notice of appeal, yet failed to submit the required appeal brief in a timely manner due to his belief that an appeal brief would not be necessary since the Technology Center Director was expected to grant his request to direct the Examiner to enter the after-final amendment.

The decision of September 2, 2006 indicated:

- "pursuant to 37 C.F.R. § 41.37(a)(1), an appeal brief must be filed within two months of the date of the filing of the Notice of Appeal;"
- Rule § 1.181(f) makes it clear that "the mere filing of a petition will not stay any period for reply that may be running against the application;"
- pursuant to M.P.E.P. § 1205.01, "the failure to timely file an appeal brief results in the appeal being dismissed and

¹ Applicant had the option of purchasing up to a five-month extension of time, which would have permitted him to submit the Appeal Brief as late as July 20, 2006, however it does not appear that any extensions of time were requested.

² Petition, page 2.

the application becoming abandoned by operation of law when there is no allowable claim," and

- "...claims 1-22, all the claims that were pending in the application, were finally rejected and appealed."

With the filing of the present petition, nothing has changed. Applicant submitted a notice of appeal, and failed to submit the required appeal brief within two months. Rule § 41.37(a)(1) and M.P.E.P. § 1205.01 each clearly indicates that an application will go abandoned if an appeal brief is not filed within two months. Applicant failed to take the appropriate step that was required to ensure against the abandonment of this application: the filing of an appeal brief while the petitions of December 20, 2005 and March 19, 2006 were pending. Instead, Applicant allowed this period of time to expire, and did not intend to file an appeal brief prior to the issuance of a decision from the Director of the Technology Center on his request for the Examiner to be directed to enter the after-final amendment of December 5, 2005.

The September 2, 2006 decision of the Technology Center Director has been reviewed. The Technology Center Director correctly indicated that pursuant to 37 C.F.R. § 41.37(a)(1), an applicant must file an appeal brief within two months of the submission of a notice of appeal, or else the application will go abandoned by operation of law. This decision further correctly indicated that pursuant to 37 C.F.R. § 1.181(f), the mere filing of a petition will not stay any period for response that may be running against the application, and as such, Petitioner was bound by the requirements of 37 C.F.R. § 41.37(a)(1), despite the fact that along with the notice of appeal, he had concurrently filed a petition requesting that the Examiner be directed to enter the after-final amendment. Finally, the decision correctly set forth the consequences of Applicant's decision to refrain from filing an appeal brief until a decision on his petition had been rendered: "pursuant to M.P.E.P. § 1205.01, the failure to timely file an appeal brief results in the appeal being dismissed and the application becoming abandoned by operation of law..."

The Deputy Commissioner for Patent Examination Policy has reviewed the September 2, 2006 decision of the Technology Center Director, and no clear error has been found.

CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.181." This is not a final agency action within the meaning of 5 U.S.C § 704.

Notice

After the filing of a renewed petition pursuant to 37 C.F.R. § 1.181, thereafter, there will be no further reconsideration of this matter^{3, 4}.

Any submission in response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail⁵, hand-delivery⁶, or facsimile⁷. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web⁸.

If responding by mail, Petitioner is advised not to place the name of the deciding official on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the decision maker.

3 For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

4 If, on the second request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will not apply to that decision.

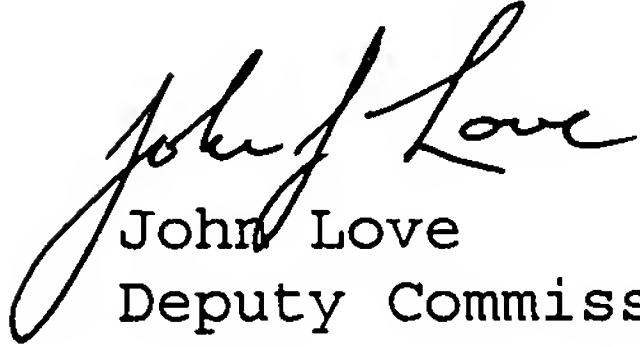
5 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

6 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

7 (571) 273-8300- please note this is a central facsimile number.

8 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Telephone inquiries regarding *this decision* should be directed to Senior Attorney Paul Shanoski at (571) 272-3225⁹. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

A handwritten signature in cursive script that reads "John Love". The signature is written in dark ink and is positioned above the printed name and title.

John Love

Deputy Commissioner for Patent Examination Policy

⁹ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.